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EXAMINER

UTAMA, ROBERT J

ART UNIT	PAPER NUMBER
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3715

NOTIFICATION DATE	DELIVERY MODE
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03/18/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/815,469	Applicant(s) HATCHER ET AL.	
	Examiner ROBERT J. UTAMA	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/23/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-11, 34-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the application

1. This office action is a response to the amendment and argument filed on 11/23/2009. The current status of the application are as follow claims 1, 5-11 and 34-35 are still pending and claims 2-4 have been cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1, 5-11 and 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "a special characteristic" in claim 1, 5-11 and 34-35 are a relative term which renders the claim indefinite. The term "a special characteristic " is not defined by the claim and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 5, 8-9, 11 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by SackSaver and as evidenced by the Breaking Barrier Reference.**

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With respect to applicant's affidavit and the resulting 102(b) rejection based on public use bar; the test for public use for of the 102(b) statutory bar is whether the purported use of: (1) was accessible to the public or (2) was commercially exploited. In this particular, the Sacksaver reference shows that the product is available and accessible to the public. The affidavit submitted by the applicant also fails to show any step that would exclude the availability of the product from the public (e.g.: non-disclosure or confidentiality agreements and etc). Furthermore, the examiner also want to point out to a new evidence that shows that the public (in this particular case Country Mart store chain) have access and used the product to train their employee as early as July-August 2002 [see Breaking Barrier reference page 5 last paragraph].

Lastly, the rejection under 102(b) is also based the "on sale" provision. The MPEP documents several "sale" definitions that can bar an invention from a patent. It has been previously decided that a single sale or offer to sale. In this particular case, the offer to sell was documented as early as September 23, 2002. As documented by the newspaper article, the Sack Saver product can be purchased at \$100 per month per store along with a \$200 set-up charge (see Breaking Barrier article page 6 last two lines).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 5, 8-9, 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckenwiller US 2003/0163292 in view of Sack Saver and further in view of Yamamoto US 5, 265,888.**

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Claim 1: The Eckenwiller reference provides a teaching of a method to train a user to pack a retail carrier bag comprising of: providing logic in a computer to evaluate whether a plurality of virtual retail carrier bags having been properly packed with a plurality of virtual purchased item (see paragraph 57 and FIG 17 "efficiency") said logic include packing criteria each virtual item having a specification including weight and dimension (see paragraph 24-25), representing plurality of different purchased item serially (see FIG 5 and see FIG 1 item 16 and paragraph 37 and paragraph 48-50); moving said plurality of virtual purchased item one at time within said computer in accordance with signals generated by said user (see FIG 3-5); evaluating in said computer how closely the packing of said plurality of virtual purchased item into said plurality of container conforms to said packing criteria (see paragraph 57 and FIG 17) and providing feedback to the user (see FIG 17 "efficiency").

The Eckenwiler reference do not provide a teaching displaying a retail carrier bag, presenting a virtual retail carrier bag and moving virtual item into a plurality of carrier bag and the Eckenwiller reference do not explicitly teaches that the items are presented in a random order.

The Eckenwiller reference do not provide a teaching of different simulated grocery item, instead the Eckenwiller reference provides a teaching where part. The examiner takes the position that main difference between the Eckenwiller reference and claimed invention in this particular case is the visual graphics that user sees. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to change the display graphics to display either things that can be interpreted as part or groceries, because Applicant has not disclosed that displaying specific graphic provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected both graphics, to perform equally well with either the graphic display because both picture the same function of visualizing the item to be packed with the container. Therefore, it would have been prima facie obvious to modify Eckenwiller to

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obtain the invention as specified in claim 1 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Eckenwiller.

The Yamamoto reference provides a teaching of presenting item in computer in a random order (see Abstract). Therefore, to provide a software that presented item in random order would have been obvious to one of ordinary skilled in the art, in view the teaching of Yamamoto, since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods (re-programming) with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention, i.e., one skilled in the art would have recognized that the random presentation used in Yamamoto would the item presentation of Eckenwiller to provide a solution from different item input presentation order.

The Sack Saver reference provides a teaching of displaying a retail carrier bag, presenting a virtual carrier bag (see Sack Saver reference FIG item 3). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of a retail carrier bag, in order to provide a simulation of different retail environment.

Claim 5: The Eckenwiller reference provides a teaching of having packing criteria that includes the number of item packed in each container (see paragraph 25 and 57).

Claim 8: The Eckenwiller reference provides a teaching of feedback that includes the weight distribution among said plurality in each container (see FIG 17 "weight").

Claim 9: The Eckenwiller reference provides a teaching of a feed that include the number of virtual purchased item in each container (see FIG 17 "#Parts").

Claim 11 and 35: The Eckenwiller reference provides a teaching of a step of recording said feedback in a database accessible to an administrator through a computer network (see paragraph 38).

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8. **Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckenwiller US 2003/0163292 in view of Sack Saver, in view of Yamamoto US 5, 265,888 and further in view of Chowdury US 6,876,958.**

Claim 6-7: Eckenwiler does not provide a teaching where the quantifying comprises of determining that a crushable one of the items in one of the organized state is in a lower position within the carrier (Claim 6, 17 and 28) or determining the breakable one of the item in one organized state is in a lower corner position within the carrier (Claim 7, 18 and 29). However, Chowdury provides a teaching where the quantifying is determined by the determining the fragile item be placed in a certain position in the container (see Chowdury col. 9:14-31). Therefore, it would have been obvious for one of ordinary skilled in the art to include the feature of quantifying by the determining the fragile item be placed in a certain position in the container, as taught by Chowdury, because it would help the user be able to take into account possible damage (see Chowdury see 9:15-20).

9. **Claims 10 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckenwiller US 2003/0163292 in view of Sack Saver, in view of Yamamoto US 5, 265,888 and further in view of Armington US 2001/0017023.**

Claim 10: The Eckenwiller reference provides a teaching of feedback that includes the total time taken by said user to pack all said purchased item into said plurality of virtual retail bags. However, the Armington reference provides a teaching of feedback that includes the total time taken by said user to pack all said purchased item into said plurality of virtual retail bags (see paragraph 75). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of feedback that includes the total time taken by said user to pack all said purchased item into said plurality of virtual retail bags, as taught by Armington, since it would allow the trainer to measure the efficiency of the student.

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Claim 34: The Eckenwiller reference provides a teaching of a GUI of a bag item and bag weight indicator (see FIG. 17), providing a computer linked means for a said person to manipulate said cursor (see FIG 1 item 12), providing specification for each different item, including weight and dimension (see paragraph 24-25), tracking a number of parameter for each training run including total weight of item and placed in each bag and whether each item were properly placed in said bag (see FIG 17 item "weight", "#parts", "Efficiency"), simulating movement of said purchased item said purchased item being presented serially (see paragraph 27 item 42). Reporting this parameter to said person (see paragraph 38) and calculating a score for each run (see FIG 17 "efficiency").

The Eckenwiller reference fails to provide a teaching of providing a computer generated GUI of a packing station; a simulation of plurality of different purchased item; a simulation of at least one packing bag; a simulation of at least one packing platform; a simulation of a conveyor belt traveling toward said packing station; an item vertical and horizontal rotate button; a new bag button; simulation of a grocery cart; allowing said person to rotate said purchased item, if necessary by clicking one or both of said rotate button with cursor; allowing said person to place at least one bag on said packing station by clicking on new bag button. The Sack Saver reference provides a teaching of a method of training of a person in the art of packaging purchased item comprising the step of: providing a computer generated GUI of a packing station (see Sack Saver item 6); a simulation of plurality of different purchased item (see Sack Saver item 1); a simulation of at least one packing bag (see Sack Saver item 3); a simulation of at least one packing platform (see Sack Saver item 6); a simulation of a conveyor belt traveling toward said packing station (see Sack Saver item 1); an item vertical and horizontal rotate button (see Sack Saver item 4); a new bag button (see Sack Saver item 2); simulation of a grocery cart (see Sack Saver item 6); allowing said person to rotate said purchased item, if necessary by clicking one or both of said rotate button with cursor (see Sack Saver item 4); allowing said person to place at least one bag on said packing station by clicking

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on new bag button (see Sack Saver item 2). Therefore, it would have been obvious to one of ordinary skilled in the feature of providing a computer generated GUI of a packing station; a simulation of plurality of different purchased item; a simulation of at least one packing bag; a simulation of at least one packing platform; a simulation of a conveyor belt traveling toward said packing station; an item vertical and horizontal rotate button; a new bag button; simulation of a grocery cart; allowing said person to rotate said purchased item, if necessary by clicking one or both of said rotate button with cursor; allowing said person to place at least one bag on said packing station by clicking on new bag button; as taught by Sack Saver, The Eckenwiller reference provides a teaching of feedback that includes the total time taken by said user to pack all said purchased item into said plurality of virtual retail bags.

However, the Armington reference provides a teaching of feedback that includes the total time taken by said user to pack all said purchased item into said plurality of virtual retail bags (see paragraph 75). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of feedback that includes the total time taken by said user to pack all said purchased item into said plurality of virtual retail bags, as taught by Armington, since it would allow the trainer to measure the efficiency of the student.

The Eckenwiller reference do not provide a teaching of different simulated grocery item, instead the Eckenwiller reference provides a teaching where of part. The examiner takes the position that main difference between the Eckenwiller reference and claimed invention in this particular case is the visual graphics that user sees. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to change the display graphics to display either things that can be interpreted as part or groceries, because Applicant has not disclosed that displaying specific graphic provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected both graphics, to perform equally well with either the graphic display because both picture the same function of visualizing the item to be packed

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with the container. Therefore, it would have been prima facie obvious to modify Eckenwiller to obtain the invention as specified in claim 1 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Eckenwiller.

The examiner takes OFFICIAL NOTICE on the feature of done button, allowing said person that has finished packing all purchased item by clicking the done button, providing linking mean for said person to manipulate said cursor (input device) and cursor as being old and well known in the art of graphical user interface. Therefore it would have been obvious to one of ordinary skilled in the art to include the feature of done button and cursor because it would enable the user to provide game input information to the system.

Response to Arguments

10. Applicant's arguments filed 11/23/2009 have been fully considered but they are not persuasive.

11. With respect to applicant's argument against the rejection under 35 U.S.C 112, second paragraph on claim 1, 5-11 and 34-35; the applicant argues that term special characteristic is defined in the specification. The examiner respectfully disagrees. The specification cited to support applicant's assertion only provides example to the term "special characteristic". The examiner takes the position since the specification fails to provide any criteria that would define a "special characteristic", one of ordinary skilled in the art would have to resort to a subjective opinion to determine whether something is a "special characteristic". It has been previously held that a term cannot depend on the unrestrained, subjective opinion of the person practicing the invention [see MPEP 2173.05(b)].

12. With respect to applicant's argument on the obviousness rejection; the applicant presented the same argument that was presented in an earlier argument (see applicant's

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argument submitted on 09/09/2008). The examiner maintains the same argument that was used on the previous office action (see office action mailed on 07/13/2009).

13. In light of the new rejection and new evidence, this office action is considered to be a non-final office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. UTAMA whose telephone number is (571)272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. U./
Examiner, Art Unit 3715

/XUAN M. THAI/
Supervisory Patent Examiner, Art Unit 3715